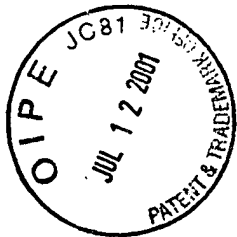


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A. Cowan



In the United States Patent and Trademark Office

Board of Patent Appeals and Interferences

Scott E. Johnston, Applicant Pro Se, Appellant

Appeal From Final Rejection of

James F. Hook, USPTO / GAU 3752, Primary Examiner

W/O  
copies  
claims

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Appn. Number: 09/312,992

APPELLANTS' BRIEF

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#### REAL PARTY IN INTEREST

The real party interest is listed above (Scott E. Johnston).

#### RELATED APPEALS AND INTERFERENCES

Not Applicable

#### STATUS OF CLAIMS

Claims 1-9 are pending in the application. Claims 1-9 are rejected.

This is an appeal from the final rejection of claims 1-9, all the claims in the application.

#### STATUS OF AMENDMENTS

Not Applicable - No amendments have been filed subsequent to final rejection.

#### SUMMARY OF INVENTION

A large diameter spirally formed pipe, having a diameter larger than similar pipe produced in the past. This pipe is round or may be reshaped into an arch shape. As a round pipe the invention includes spirally formed pipes above 15 feet in diameter, and as a round pipe reshaped into an arch shape, the invention includes, spirally formed pipes above 144 inches in diameter before being reshaped into an arch shape. This large diameter spirally formed pipe allows for the manufacture of products that have been traditionally produced by other means.

(Appellant's Abstract of the Disclosure)

FIG. 2 of the appellant's drawings provides a schematic representation of the pipe generally designated 10. Page 3 of the specification lines 16-27 provides details of construction as follows:

The pipe is composed of an elongated strip of ductile material, such as galvanized steel, which is formed into adjacent, helical convolutions. As illustrated, convolutions 14 are joined at 12.

Convolutions 14 form the wall of the pipe which may be smooth, corrugated or profiled.

Section view FIG. 5. illustrates the variety of pipe wall styles. The smooth wall 16 is joined by a welded seam 15, the corrugated wall 18 is joined by a conventional double lock seam 17, and the profiled wall 22 is joined by a conventional double lock seam 21. As the pipe diameter is increased, the thickness of material and size of corrugation or profile is typically also increased.

So then, in most cases the dimensional proportions of the smooth, corrugated and profiled wall increases as pipe size is increased, although if desired can be held to a smaller size for some applications.

The pipe 10 may be round as shown in FIG. 3, or reshaped into an arch shape as shown in FIG. 4. A pipe according to the invention is larger than 15 feet in diameter when left in the round shape, and a pipe according to the invention is larger than 144 inches in diameter if it is then reshaped into an arch shape.

Page 1 and 2 of the specification provides background for the invention. The fact that large diameter pipe and arch shapes have been produced from bolted or welded together sections of material is discussed. That these products require a crew of skilled workers, a large lifting device, and considerable time to assemble.

Under the detailed description of the invention on Pages 2 and 3 many of the new uses for spirally formed pipe are discussed. Referring to FIG. 1, highway overpasses 52, barns or storage buildings 37, homes 45, grain silos 32, water tanks 61 are shown along with traditional uses such as storm drain 21, and pile pipe or shell 67. It is stated on page 3 lines 12-15, Traditional uses such as highway storm drain 21 and pile pipe or shell 67 are well known uses for spirally formed pipe, while overpasses 52, storage buildings 37, homes 45, silos 32 and water tanks 61 being larger in diameter, have generally been produced from formed metal panels with bolted or welded construction.

Page 2 lines 9-15 disclose that the appellant has developed new machinery for producing "Large Diameter Spirally Formed Pipes", and Large Diameter Arching Machinery" capable of producing Large Arches. The Portable Spiral Pipe Machinery and the Arching Machinery are both now patented, (U.S. Patent No. 6,000,261 and 6,260,403). This illustrates that invention was required to produce the claimed "Large Diameter Spirally Formed Pipe".

## ISSUES

1.) The examiner has rejected claims 1-9 under 35 U.S.C. § 102(b) as being anticipated by the reference of "The Handbook of Steel Drainage and Construction Products". The appellant provided nine arguments to refute this rejection (appellants' Amendment B), most of which remain unanswered.

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2.) The examiner has rejected claims 1-4 under 35 U.S.C. § 102(b) as being anticipated by or in the alternative 35 U.S.C. § 103(a) as obvious over Holcomb. The appellant provided twelve arguments to refute this rejection (appellants Amendment B), most of which remain unanswered.

3.) The examiner has rejected claims 5-9 under 35 U.S.C. § 103(a) as being unpatentable over Holcomb in view of the Handbook of Steel Drainage. The appellant provided ten arguments to refute this rejection (appellants' amendment B), most of which remain unanswered.

4.) The response to arguments provided in the final office action can best be characterized as a sweeping two page paragraph containing opinions and comments, presented with authority and finality. Five or Six of the arguments appear to have been addressed but it remains unclear how they should be applied.

5.) It is the appellants' primary concern that the examiner be reversed on all of the above claim rejections.

6.) In addition, if the Board of Patent Appeals and Interferences should agree with the appellant and reverse the decision of the examiner, the appellant would like further consideration of the claim rejections under 35 U.S.C. § 112 of the examiners first office action. The appellant was compelled to modify claims 1 and 5 with Amendment A. The Appellant would like to cancel Amendment A to restore the claims to their original condition.

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## GROUPING OF CLAIMS

The appellant is concerned that the selection of a claim to represent a group of claims be applied to independent (base claims) claims only. Since the examiner has rejected claims 1-9 under 35 U.S.C. § 102(b) it seems that claims 1, 5, and 9 should be reviewed to determine if, in fact, the invention as claimed is actually anticipated in every form claimed. For the rejections of claims 1-4 under 35 U.S.C. § 102(b) or in the alternative, 35 U.S.C. § 103, claim 1 should be relied upon, and for the rejection of claims 5-9 under 35 U.S.C. § 103, claim 5 should be relied upon, however claim 9 should also be reviewed to determine if the rejections should apply to it as well. These base claims potentially identify significant variations of the claimed invention that could be used to distinguish the invention from the prior art.

## ARGUMENT

As an applicant pro se, it is extremely disturbing to be in the position of appealing to the Board of Patent Appeals and Interferences. This is my third patent, covering inventions related to Spirally Formed Pipe and it's Manufacture. The patent process itself has been a wonderful experience, except for my most recent experiences. It is a great challenge to file patents and respond to office actions. Considerable time, effort, financial obligation and stress are all factors an individual must face when seeking to obtain patent protection, and this is acceptable, when the process is *fair*.

The repeated rejections of the final office action, were soundly argued against in my response to the prior office action. These rejections contain obvious mistakes of a factual nature. It was possible that the examiner misunderstood the references the first time, but to restate the same rejections with the same choice of words, at this point, is to knowingly distort the teachings of the references. It's personally insulting, but more importantly it's *unfair*.

1.) Referring to the Handbook of Steel Drainage, the examiner's final office action (pg 2, item 2) implies that there is language referring to spirally formed pipes, as conventional pipes, and that

"it is noted that conventional pipes of this type are capable of ranging in diameters from 6 inches to 21 feet in diameter". This language does not exist within the reference cited (expressed or

implied). This unfounded statement is at the heart of the examiners' rejection!

*In rejection* On what page can the notation be found? What does the note actually say? On what page can one find mention of conventional pipes? If the statement is a paraphrase, or summary, there should be some text within the reference to provide the alleged facts that have been asserted.

Can a statement that is not supported within the reference be used to identify an anticipation?

2.) Claims 1-4 were rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, 35 U.S.C. § 103(a) as obvious over Holcomb. Again we have an unfounded statement at the heart of the examiners' rejection. Page 3, item 4, of the final office action states:

"It is taught that conventional pipes of this type are capable of ranging in diameters from 6 inches to 21 feet in diameter and it is implied that the pipe in Holcomb can also be made up to those dimensions if such were needed, where the dimensions are not considered limited by the examples tested in Holcomb."

*In steel drawings Holcomb* The reference of Holcomb is only six pages long including drawings, it is a short read. It can be read through several times easily. It does not contain any mention of testing, examples tested, sizes studied, etc. Again we have the unfounded "conventional pipes of this type" phrase, and most importantly "it is implied that the pipe in Holcomb can be made up to those dimensions if such were needed". Where is it "implied"? Again, can a statement that is not supported within the reference be used to identify an anticipation? Can the examiner hold the position "if such were needed" and still prove the motivation required to support a case for obviousness?



3.) Claims 5-9 were rejected under 35 U.S.C. § 103(a) as being obvious over Holcomb in view of The Handbook of Steel Drainage. On page 3 item 5 of the final office action the examiner states: "The patent to Holcomb discloses all of the recited structure with the exception of reshaping the tube as an arch." This has not been established. The reference does not teach of a spirally formed pipe above twelve feet in diameter. The rejection concludes with the statement: "It would have been obvious to one skilled in the art to modify the shape of the pipe in Holcomb to be reshaped into an arch shape to provide a different profile which can be stronger as suggested by The Handbook of Steel Drainage." *There is no suggestion in the reference that arch pipe is somehow stronger than round pipe.* Where is this suggestion found? What page is it on?

4.) The examiners, "*Response to Arguments*" on page 4 item 6 of the final office action is replete with distortions and unfounded statements. First the examiner asserts, "The argument that Holcomb teaches only making the pipe in certain ranges is not considered persuasive", then provides a broad, groundless statement, backed up with Holcomb's alleged testing of pipes. Again, the Holcomb reference does not contain any mention of testing, examples tested, sizes studied, etc. Next, the focus is turned to the teachings of the Handbook of Steel Drainage, with statements regarding "steel conduits". The term "steel conduits" is a generic term referring to a wide range of products, it does not identify spirally formed pipe, any more or less than it can be utilized to identify the "Median and shoulder spillway drain" as seen in on page 22, Fig. C-1. This photograph pictures an elongated gutter pan of corrugated plates, it is not a pipe, but it is a "steel conduit". The examiners' teaching regarding the table on page 38 and the alleged

description on page 40, is so appalling, as to render one speechless. The examiner proclaims, "Further the table on page 38, and the description on page 40 state that pipes can be formed in round shapes up to 21 feet in diameter, and 20 feet 7 inches for arched conduits, where page 40 sets forth that this is true of lock seamed corrugated tubing." Page 40 provides no mention of the large round shapes and arched conduits illustrated on page 38, and more importantly the only diameters mentioned are 6, 8, and 10 inch and also diameters to 120 inch. There is no mention of arched pipe of any size. Is this type of conjecture, and or fabrication acceptable?

The final office action goes on to say (page 4 and 5), "With respect to the argument of hindsight for the Steel Drainage reference, such is not persuasive in that hindsight reasoning can only be applied to cases of obviousness, which refers only to rejections under 35 U.S.C. § 103(a)."

The examiner then goes on to quote from paragraph 7.37.03 from the MPEP. This is contradictory. Is the examiner suggesting that of necessity some degree of hindsight reasoning has been applied? If this is the case how can this reference be utilized under 35 U.S.C. § 102.?

On page 5 line 10 The examiner states "a change in diameter is not a patentable feature."

This, likely is the reason the examiner has gone to such extremes to defeat this application.

Generally it's true, and well supported that merely following in the steps of prior teachings and increasing or decreasing the size of an article is not the result of invention. In fact, in most cases it is simply an issue of obviousness. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) is a

perfect example, anyone utilizing the teachings of one of the many prior art references could have simply added a few more pieces of lumber and created an infringing stack of lumber. This is not at all the case with Spirally Formed Pipe. To produce a pipe as the appellant has claimed requires invention

Page 5 lines 11-15 of the examiners final office action states "it is immaterial what apparatus is used or what method is used to make the article when claiming an article." This speaks directly to why the references did not anticipate or render obvious the appellants' invention. The examiner has missed the fact that it requires invention to produce the Large Diameter Spirally Formed Pipe products as claimed. It is not immaterial, the method used to make the article, it is, in fact, of the essence.

Next, the examiner asserts "It is also not pertinent to argue the method in which the article is supplied to the work site, such is essentially the same as any other method claim in an article claim, it holds no patentable weight". The appellant did not argue which method could be utilized to supply the article to the work site, but rather that the article as claimed could not be supplied to the work site by those skilled in the art of the references. The point being, the references do not anticipate, or render obvious the appellants' invention because they do not address or resolve the issue how to supply this large pipe product to the work site. This again speaks to the fact that it requires invention to produce the Large Diameter Spirally Formed Pipe products as claimed.

The examiner then states "The various uses for the article disclosed in the arguments is also immaterial when such is not being claimed". The examiner has missed the fact that these arguments generally were presented to illustrate that the claimed invention provides for unexpected results, unappreciated advantages, solves unrecognized problems and so on.

Where has the examiner addressed these arguments?

Next, the examiner addresses the argument that the Steel Drainage reference teaches of other forms of pipe in addition to spirally formed pipe and states "even though the reference teaches other embodiments it does not prevent it from disclosing the embodiment claimed by applicant". This response provides no information to support the examiners' position, it is simply a statement of possibility. Where has the examiner found the "embodiment claimed by applicant"? Is the examiner suggesting that it's acceptable to combine embodiments of one product with embodiments of another product within the reference to argue an anticipation under 35 U.S.C. § 102(b)?

On page 6 of the final office action the examiner finishes his response to arguments by returning to the Holcomb reference and continues his assertion that tables A and B refer to ranges tested. Both arguments of hindsight reasoning and the fact that Holcomb actually teaches away from the suggested combination are apparently being contested, but no supporting information is provided. Again, please note that there is no mention of "ranges tested, sizes tested, studied, etc" in the reference of Holcomb.

5.) In accordance with the MPEP - Section- 707.07(f) the examiner should answer "All Material Traversed". At best the examiners' response addressed six (6) arguments, while over twenty (20) were actually presented. The examiner did not identify the arguments being addressed, and did not provide the basis for the examiners' positions. In short, the examiners' final office action is completely unacceptable. No factual basis has been provided to support the examiners' rejections. The decision of the examiner must be reversed; which action the appellant now respectfully requests.

6.) What does The Handbook of Steel Drainage actually teach? First the chart on page 38 does not mention spirally formed pipe, or the reshaping of pipe. It does, however, refer to "plates", in all of the examples. Those skilled in the art recognize that spirally formed pipe is "shop fabricated", meaning, that it is made at a factory, then shipped to the job site. The following paragraph is taken directly from the reference of the Handbook of Steel Drainage (pg. 39, 2nd paragraph):

"Corrugated metal pipe was first developed and used for culverts in 1896. As experience was gained in the use of this thin-wall, lightweight, *shop-fabricated* pipe, the diameters gradually increased to 96 in. and larger. Fill heights became greater, even exceeding 100 ft. A further development, in 1931, was structural plate pipe with larger corrugations, for *field assembly*. Diameters and arch spans beyond 25 ft. have been successfully installed."

The larger sized pipe products, referred to, within the reference are made from "structural plates" which are shipped to location and "bolted together". All of the illustrations, charts, photographs, and text support this position. Page 40 of the Handbook of Steel Drainage, discusses corrugation profiles for various pipes and refers to spirally formed pipe as lock seam pipe; it states:

"For lock seam pipe, the seams and corrugations run helically (or spirally) around the pipe. For small diameters of sub drainage pipe (6, 8, 10 in., etc.) the pitch vs. depth dimension is  $1\frac{1}{2} \times \frac{1}{4}$  in. Larger sizes (with diameters to 120 in.) use  $2 \times \frac{1}{2}$  in.,  $2\frac{2}{3} \times \frac{1}{2}$  in. and  $3 \times 1$  in. corrugations."

It can be seen from these two paragraphs that the examiner's position is not supported by the reference. A review of the reference reveals that there is no mention of a spirally formed pipe that would meet the claims. The reference can not be utilized as an anticipation.

7.) Holcomb actually teaches of producing a pipe product that deviates from the standards set forth in the Handbook of Steel Drainage. The Holcomb patent column 2 lines 29-56 discusses that the pipes as specified in The Handbook of Steel Drainage are much stronger than needed for many applications, concluding "the engineer is forced to specify an unnecessarily expensive product." The Holcomb invention is to produce the  $2\frac{2}{3} \times \frac{1}{2}$  in. and  $3 \times 1$  in. corrugation profile pipe product with a space between each corrugation (see Holcomb patent FIG. 2A and FIG. 3), please recall that page 40 of The Handbook of Steel Drainage identifies these

corrugations as being for Larger sizes (with diameters to 120 in.). This reference can not be utilized as an anticipation.

8.) Under the section in the MPEP, Distinction Between 35 U.S.C. § 102 and § 103, it states that “The distinction between rejections based on 35 U.S.C. § 102 and those based on 35 U.S.C. § 103 should be kept in mind. Under the former (35 U.S.C. § 102) the claim is anticipated by the reference. No question of obviousness is present. In other words, for anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present.”

Neither The Handbook of Steel Drainage or the patent to Holcomb disclose each and every element of the claimed invention. It is therefore apparent that the examiner's anticipation rejections raise the question of inherency with respect to the reference structures. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. The examiner must provide some evidence or scientific reasoning to establish the reasonableness of the examiner's belief that the functional limitation is an inherent characteristic of the prior art. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and In re Swinehart, 439 F.2d 210, 213, 169 USPQ 226, 229 (CCPA 1971). The examiner has provided no such evidence or reasoning with regard to these references. It is also apparent from a thorough review of the references that any such evidence or

reasoning the examiner might put forth, will of necessity be somehow contorted, or abstract.

With this in mind, these arguments, if any, should be considered in light of the following:

A reference so obscure in its terminology that two conflicting theories as to its meaning may be deduced therefrom and supported by equally plausible arguments is too indefinite to be utilized as an anticipation. (see *Cimiotti Unhairing Co. et. al v. Comstock Unhairing Co. et. al.*, 115 Fed. Rep. 524.)

9.) There is nothing in these references that would enable one skilled in the art to produce spiral pipe at the jobsite. Furthermore, absent the ability to produce the pipe at the jobsite, there is nothing in the reference that would enable one skilled in the art to convey such a large pipe to location, or for that matter to explain the necessary modifications required for the factory machinery to produce larger sizes of pipe, i.e., tooling, pipe support modifications, etc. To reshape a spirally formed round pipe into an arch shape requires a substantial piece of equipment. There is nothing in the references that would enable one skilled in the art to produce and or reshape a spirally formed pipe of any size.

**§ 119. Sufficiency of description** (60 Am Jur 2d.)

In order for a prior art printed publication to anticipate an invention, the description thereof must disclose the complete and operative invention in such full, clear, and exact terms as to enable any person skilled in the art to which it pertains to practice the invention to the same extent as he



would have been enabled to do so if the information were derived from a prior patent. In short, a printed publication is to be tested by the same rules as those applicable to a prior printed patent.

An article does not anticipate an invention under 35 U.S.C. § 102(a) if it is not so particular and definite that one versed in the art could gain possession of the claimed subject matter without undue experimentation. *In re Sheppard*, 52 CCPA 859, 339 F.2d 238, 144 USPQ 42.

The examiner must go beyond merely presenting a theory, to support inherency. It must be demonstrated that one of ordinary skill in the art would be enabled to make the claimed invention.

**D.Del. 1990.** Even if a prior printed publication discloses the claimed invention, it will not suffice as prior art if it was not enabling; therefore, defendant must show that each element of claim in issue is found in the prior patent or publication, either expressly or under the principles of inherency and that one of ordinary skill in the art could have combined the publication's description of invention with his own knowledge to make the claimed invention. 35 U.S.C. § 102(b). *General Elec. Co. v. Hoechst Celanese Corp.*, 740 F.Supp. 305.

**D.Del. 1989.** Any degree of physical difference between inventions, however slight, invalidates claims of anticipation in a patent infringement action. *E.I. du Pont de Nemours & Co. v. Polaroid Graphics Imaging, Inc.*, 706 F.Supp. 1135, affirmed 887 F.2d 1095, rehearing denied.

10.) The appellants' FIG. 1 provides illustrations for various products not found in the references.

*not claimed*  
With the appellants' new Spirally Formed Pipe invention it is possible to produce pipes with much larger corrugations, without the limitations of a bolted structure. Just one example of the incredible possibilities is Highway Overpasses. The pipes required can be made in a day, a completed overpass could be produced in a few weeks. A concrete or traditional steel bridge design, requires months to build, are potentially more environmentally disruptive, particularly when they have exceeded their useful life. Spirally Formed Pipes are completely recyclable as scrap metal. There are other advantages as well, and of course many other uses. The bolted together pipe products shown in The Handbook of Steel Drainage, do not function the same way as the appellants' invention, they do not produce the same results. "It's a New World" when it comes to steel pipe products, Large Diameter Spirally Formed Pipes are about to revolutionize several industries. Bridges, homes, shelters, and so on, made faster, providing greater safety and value than competitive products.

**CI.Ct. 1986.** Anticipation or lack of novelty under patent law is established only when single prior art reference expressly describes or inherently contains each element of claimed invention, functioning in substantially the same way to produce substantially the same result. 35 U.S.C. § 102(a). *Pacific Technica Corp. v. U.S.*, 11 CI.Ct. 393, affirmed in part and vacated in part 835 F.2d 871.

**N.D.III. 1986.** There can be no anticipation of invention unless all of the same elements are found in exactly same situation and united in same way to perform identical functions in a single prior art reference 35 U.S.C. § 102(a). *Water Technologies Corp. v. Calco, Ltd.*, 658 f.Supp. 961, amendment denied 658 F.Supp. 980, affirmed in part, reversed in part 850 f.2d 660, certiorari denied 109 S.Ct. 498, 488 U.S. 968, 102 L.Ed.2d 534, on remand 714 F.Supp. 899, on remand 709 F.Supp. 821.

11.) Regarding the examiner's rejections under 35 U.S.C. § 103. It is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972, 973 (BPAI 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F. 2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir.) cert. denied, 488 U.S. 825 (1988). According to the Manual of Patent Examiners Procedures, "The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done." The examiner has stated "Holcomb can also be made up to those dimensions if such were needed" (page 3 of the final office action). This would imply that the examiner does not see any desirability in doing what the inventor has done. There is no teaching, suggestion or inference in the prior art to support a rejection under 35 U.S.C. § 103.

With regard to the examiners' rejection of claims 5-9, Holcomb in view of The Handbook of Steel Drainage. The examiner is perhaps attempting to provide the requisite motivation, when it is implied that The Handbook of Steel Drainage suggests arched pipe is somehow stronger than round pipe. This teaching is not found in The Handbook of Steel Drainage, but even if it were the Federal Circuit states that "(the) mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification". In re Fitch, 972 F.2d 1260, 1266 n.4, 23 USPQ2d 1780, 1783-84 n.4 (Fed. Cir. 1992), citing In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The examiner's rejection states, that "Holcomb discloses all of the recited structure with the exception of reshaping the tube as an arch". This has not been established. If it is somehow dependent upon the earlier rejection of claims 1-4, it is again inescapable that the examiner stated "Holcomb can also be made up to those dimensions if such were needed". Again, there is no teaching, suggestion or inference in the prior art to support a rejection under 35 U.S.C. § 103.

12.) Continuing with rejections under 35 U.S.C. § 103, the examiner must not only provide some suggestion of the desirability of doing what the inventor has done, but must also present that there would be a reasonable expectation of success. See MPEP -- SECTION-- 706.02 "the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure". In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The appellant has presented a number of arguments and

supporting documentation to show that in the absence of new machinery capable of producing the Large Diameter Spirally Formed Pipe at the job site, shipping the article as claimed to the job site is not possible. Any argument supporting a reasonable expectation of success should certainly provide some suggestion, or evidence to illustrate how success can be achieved without solving this problem. Additionally, the appellant notes that the factory machinery would require modifications not taught in the prior art to produce pipes as claimed, and the Arching Equipment to arch pipes as claimed did not exist. The examiner has not provided any evidence of a suggestion, teaching, or motivation to modify any of the references or combination of references. The range of sources available, does not diminish the actual requirement for actual evidence. That is, the showing must be clear and particular. See e.g., C. R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) A broad conclusory statement regarding the obviousness of modifying a reference, standing alone is not "evidence". E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

"Mere denials and conclusory statements, however are not sufficient to establish a genuine issue of material fact."; In re Sichert 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977).

Broad conclusory statements are all the examiner has provided, and within these statements there are obvious mistakes of a factual nature. The decision of the examiner must be reversed, which action the appellant now respectfully requests.

12.) All of the above arguments have been presented to see that the examiner is reversed on the claim rejections of the final office action. In this next argument, I am really asking the board for a favor. The examiner's first office action of May 8, 2000, contained claim rejections under 35 U.S.C. § 112, which were in error. The examiner contends that "A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired." The claims in question actually include "whereby" statements, which are in some ways clarifying. Claim 1 as originally presented is as follows:

1. A spirally formed pipe, comprising an elongated strip of ductile material formed into joined, adjacent helical convolutions, having a diameter larger than 15 feet, whereby said pipe is larger than similar pipe produced in the past.

The "whereby" statement is not necessary for the claim to provide the patent protection desired. It does however, help to clarify that this is not just "a change in diameter", but a change in the range of sizes that have been available up till now.

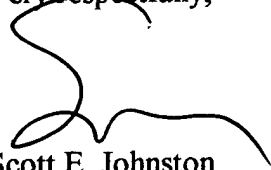
The appellant would like to cancel Amendment A to restore the claims to their original condition.

## CONCLUSION

Just one argument, if justified, should be enough to prevail with an examiner. My experience, however limited in this area causes me to conclude that arguments are not easy to come up with, unless they are in fact warranted. In the case of this Large Diameter Pipe application, there have been numerous arguments presented. All of the arguments are still valid. The examiners response did not address the substance of these arguments. Please refer to Amendment B for the actual arguments presented.

As an Applicant Pro Se and now as the Appellant, I am very concerned that I receive this patent on Large Diameter Spirally Formed Pipe. Please accept this appeal, and Reverse the Examiner.

Very respectfully,

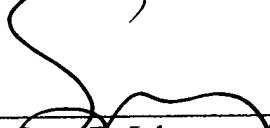
  
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July 12, 2001

  
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Scott E. Johnston, Applicant/Appellant